

BEST AVAILABLE COPY



UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/519,584 07/19/00 BERNANDON

021839 HM22/1219  
BURNS DOANE SWECKER & MATHIS L L P  
POST OFFICE BOX 1404  
ALEXANDRIA VA 22313-1404

J 016800-390
EXAMINER

ART UNIT 1616	PAPER NUMBER 4
---------------	----------------

DATE MAILED: 12/19/00

12/19/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.  
09/619,584

Applicant  
Bernarden et al.

Examiner  
Sabiha Qazi

Group Art Unit  
1616



☒ Responsive to communication(s) filed on Jul 19, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 12-32 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☐ Claim(s) \_\_\_\_\_ is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☒ Claims 12-32 are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1616

***Election/Restriction***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 12-32 drawn to compounds and composition of the formula in claim 12 when Ar is pyridine ring(b), and is the only hetero group present in the compound, classified in class 546, subclass 249+.
- II. Claims 12-32 drawn to compounds and composition of the formula in claim 12 when Ar is furan ring(c), and is the only hetero group present in the compound classified in class 549, subclass 200+.
- III. Claims 12-32 drawn to compounds and composition of the formula in claim 12 when Ar is thiophene ring(d), and is the only hetero group present in the compound classified in class 549, subclass 1+.
- IV. Claims 12-32 drawn to compounds and composition of the formula in claim 12 when Ar is aryl ring (a), and no hetero group present in the compound classified in class 562, subclass 1+; 560, subclass 1+ and various other classes.
- V. Claims 12-32 drawn to compounds and composition of the formula in claim 12 when Ar is pyrrolidine ring (e) and is the only hetero group present in the compound, classified in class 546, subclass 249+.

If applicants want to elect the invention other than those cited above, they may elect a species and Examiner will build a group as cited above of the subgenus falling in the species for examination.

The inventions are distinct each from the other because of the following reasons:

Art Unit: 1616

1. The groups I-V as outlined above are drawn to the invention which require separate searches, and are not art recognized equivalents. They are patentably distinct.

Burden is likewise demonstrated by divergent classification and database search for the entire genus would represent excessive burden on the examiner.

2. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper. A reference used to reject one invention would not be used for any other invention cited in the above groups.

3. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species from the elected group, even though this requirement is traversed.

4. A telephone call was made to Attorney Norman H. Strpno on 11/17/00 to request an oral election to the above restriction requirement, but did not result in an election being made.

5. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

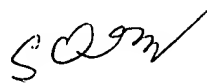
Art Unit: 1616

7. It is suggested that in order to advance prosecution, the non elected subject matter be cancelled when responding to this office action.

**Telephonic Inquiry**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sabiha N. Qazi, whose telephone number is (703) 305-3910. The examiner can normally be reached on Monday through Friday from 8 a.m. to 6 p.m. The fax phone number for this Group is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.



**Sabiha N. Qazi, Ph.D.**

**Primary Examiner**

**Art Unit 1616**

12/1/00